

REMARKS

In the Office Action¹ mailed August 2, 2007, claims 1, 17, 33 and 46-54 were rejected under 35 U.S.C. §102(a) as being anticipated by Pub No. US 2003/0046281, by Son (hereinafter "*Son*"). Also, claims 2-16, 18-32 and 34-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Son* and further in view of US Pat No. 5,222,234, by Wang et. al. (hereinafter "*Wang*"). Claims 1-54 are pending in the application of which claims 1, 17 and 33 are independent.

Remarks regarding amendments

Specification

The amendment to the Specification corrects two (2) typographical errors. No new matter is introduced by the foregoing amendments.

Claims

By this Amendment, Applicant also amends independent claims 1, 17 and 33 to more appropriately define Applicant's invention. No dependant claims are amended.

35 U.S.C. §102(a) Rejection

In the Office Action, claims 1, 17, 33 and 46-54 were rejected under 35 U.S.C. §102(a) as being anticipated by *Son*. To properly establish that a prior art reference anticipates a claimed invention under 35 U.S.C. §102, each and every element of the

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

claims in issue must be found, either expressly described or under principles of inherency, in the single prior art reference.

Applicant respectfully traverses the rejection of claims 1, 17, 33 and 46-54 since *Son* fails to teach each and every element of these claims. For example, *Son* does not disclose at least the following elements found in claim 1: “providing an input mechanism by means of which a user may **select from the at least one search result, for preservation**, at least one resource identified in the at least one search result” (emphasis added) or “executing, **in response to the user’s selection, a command to preserve the content of the selected at least one resource** in a system location” (emphasis added). The Office Action cites *Son*’s para. 0101 to demonstrate that *Son* discloses the elements listed above. However, nowhere in *Son* para. 0101, or elsewhere in *Son*, is there a suggestion of **selecting at least one resource to be preserved** as recited in claim 1.

Son’s para. 0008 discloses an information search system for providing user terminals with a search service for identifying content in a central database. The system receives a user search request, searches the content database on behalf of the user, presents search results to the user, and records and retains the search results returned by the search request. See *Son* at para. 0008. In addition, in *Son* para. 0101, the user selects content from the search result, and issues a request to get the content. However, *Son* at 0101 or elsewhere does not disclose selecting “for preservation, at least one resource....” Moreover, the *Son* system does not execute a command to preserve the selected content. As such, the cited portions of *Son* cannot teach or

suggest “providing an input mechanism by means of which a user may select from the at least one search result, for preservation, at least one resource identified in the at least one search result” or “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in a system location,” as recited in claim 1.

For at least this reason, claim 1 is allowable under 35 U.S.C. §102(a). For at least the reasons stated above with respect to claim 1, claims 17 and 33 which recite similar elements and were rejected under the same rationale, are allowable under 35 U.S.C. §102(a). See Office Action at 2-3. Additionally, claims 46-54 are also allowable at least since they depend on claims 1, 17 and 33.

For these reasons, Applicant’s claims are patentably distinct from *Son*. Applicant respectfully requests the rejection under 35 U.S.C. §102(a) of independent claims 1, 17 and 33 and claims 46-54, which depend therefrom, to be withdrawn.

Rejection under 35 U.S.C. §103

Applicant respectfully traverses the rejection of claims 2-16, 18-32 and 34-45 under 35 U.S.C. §103(a) as being unpatentable over *Son* in view of *Wang*. To establish a *prima facie* case of obviousness, the prior art (separately or combined) must teach or suggest all the claim limitations. See M.P.E.P. §2142, 8th Ed. Rev. 5(August 2006). Moreover, “in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the

manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

Turning first to the rejection of claims 2-16, a *prima facie* case of obviousness has not been established because, among other things, the prior art taken alone or in combination, fails to teach or suggest each or every element of claims 2-16.

Claims 2-16 depend from claim 1, and thus include all the elements and limitations thereof. As set forth above with respect to claim 1, *Son* fails to teach, disclose or suggest the features recited in claim 1, and required by claims 2-16, namely “providing an input mechanism by means of which a user may select from the at least one search result, for preservation, at least one resource identified in the at least one search result” or “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in a system location.” The Office Action cited *Wang*, alone or in combination with *Son*, as a teaching of the features recited in claims 2-16 but not recited in claim 1. Even assuming the Office Action’s characterization of *Wang* is correct, *Wang* fails to cure the deficiencies of *Son* discussed above. That is, *Wang* also fails to teach, disclose or suggest “providing an input mechanism by means of which a user may select from the at least one search result, for preservation, at least one resource identified in the at least one search result” or “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in a system location,” as recited in claim 1 and required in claims 2-16. Thus, the prior art, taken either alone or in an reasonable combination, fails to teach or suggest all of the elements of claims 2-16.

For at least this reason, a *prima facie* case of obviousness with respect to claims 2-16 have not been proved. The rejection of claims 2-16 under 35 U.S.C. §103 as being obvious from *Son* in view of *Wang* is thus improper and should be withdrawn.

For at least the reasons noted above, claims 18-32 and 34-45, which recite similar elements rejected under the same rationale, are allowable under 35 U.S.C. §103(a). See Office Action page at 3-7.

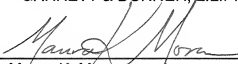
In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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